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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/390,937	09/07/1999	IGOR V. KARPENKO	VISAP022/P10	7838

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EXAMINER

DIXON, THOMAS A

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 08/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/390,937

Applicant(s)

KARPENKO, IGOR V.

Examiner

Thomas A. Dixon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election with traverse of group I in Paper No. 3, filed 21 May 2002 is acknowledged. The traversal is on the ground(s) that a prima facie case of distinctness or burden was not shown. This is found persuasive and the requirement withdrawn.

***Claim Rejections - 35 USC § 102***

2. Claims 1-4, 6-8, 20, 24-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Crooks et al (6,052,671).

As per Claim 1.

Crooks et al ('671) discloses:

receiving a utility reading, the utility reading being a measure of the usage of the utility by a customer, wherein the utility reading is received from a first remote location across a first transmission medium, see figure 7, (65, 20) and column 2, lines 5-30;

determining an amount, wherein the amount is determined using the utility reading, see figure 12 (124);

transmitting the amount to a second remote location, the amount being transmitted to the second remote location across a second transmission medium, wherein the second remote location is arranged to effect a payment of the amount by a customer see figure 7 (58).

As per claim 2.

Crooks et al ('671) further discloses:

the first transmission medium is a network communications line, see column 2, lines 28-30.

As per claim 3.

Crooks et al ('671) further discloses:

the second transmission medium is a network communications line, see column 2, lines 28-30.

As per claim 4.

Crooks et al ('671) further discloses multiple sites associated with a customer, see figure 7 (58a-c), and receiving address information associated with a location of a meter, see figure 9 (110).

As per Claim 6, 25.

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Crooks et al ('671) further discloses:  
transmitting the amount across a global telecommunications network, the global telecommunications network being arranged to substantially perform clearance and settlement transactions, see column 2, lines 26-30.

As per Claim 7.  
Crooks et al ('671) further discloses:  
generating a credit message using the amount, wherein transmitting the amount to the second remote location includes transmitting a credit message to the second remote location, see figure 5 (235, 270).

As per Claim 8.  
Crooks et al ('671) further discloses:  
generating a debit message using the amount wherein transmitting the amount to the second remote location includes transmitting the debit message to the second location, see figure 5 (235, 270)

As per Claim 24.  
Crooks et al ('671) discloses:  
receiving a utility reading, the utility reading being a measure of the usage of the utility by a customer, wherein the utility reading is received from a first remote location across a first transmission medium, see figure 7, (65, 20) and column 2, lines 5-30;  
determining an amount, wherein the amount is determined using the utility reading, see figure 12 (124);  
transmitting the amount to a second remote location, the amount being transmitted to the second remote location across a second transmission medium, wherein the second remote location is arranged to effect a payment of the amount by a customer, see figure 7 (58)  
a computer readable medium for storing the computer codes, see figure 1 (26, 28).

3. Claims 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Chasek (5,894,422).

As per Claim 15.  
Chasek ('422) discloses:  
an electronic meter reader, wherein the electronic meter reader is arranged to electronically obtain meter counts associated with the usage of the utility, see column 4, lines 6-31;  
a processor-memory unit, the processor-memory unit being coupled to the electronic meter reader, the processor memory unit being arranged to process and store information relating to the usage of the utility, wherein the information includes the

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meter counts obtained from the electronic meter reader, see column 4, line 31 – column 5, line 13;

a connection mechanism, the connection mechanism being coupled to the processor-memory unit, wherein the connection mechanism is arranged to allow the processor-memory unit to transmit the processed information to a substantially remote receiving device, see column 4, lines 14-16.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Crooks et al (6,052,671) in view of Chasek (5,894,422).

As per claim 5.

Crooks et al ('671) further discloses multiple sites associated with a customer, see figure 7 (58a-c), and receiving address information associated with a location of a meter, see figure 9 (110).

Crooks et al ('671) does not specifically disclose receiving a unit code, the unit code being arranged to identify the units associated with the utility reading.

Chasek ('422) teaches a unit sending a customer identification code stored in a PROM, see column 4, lines 6-31, as a known method of identifying a meter during the meter reading.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to identify the metered sites of Crooks et al ('671) with a customer identifier as taught by Chasek ('422) to individually identify each meter during the collection of meter readings.

5. Claim 9, 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Crooks et al (6,052,671) in view of Thompson (4,948,174).

As per claims 9, 26.

Crooks et al ('671) further discloses customer payment through the ACH system, see column 6, lines 30-49..

Crooks et al ('671) does not specifically disclose VisaNET.

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Thompson et al (4,948,147) teaches use of Visa or MasterCard, see column 10, lines 8-10 and further equivalency of ACH, credit card or ATM as payment systems; see column 17, lines 54-63 for the benefit of customer convenience.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to utilize VisaNET as a design choice equivalent to any credit card or ACH or ATM system for the benefit of customer convenience.

6. Claim 10-12, 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chasek (5,894,422) in view of Thompson (4,948,174).

As per Claim 10.

Chasek ('422) discloses:

electronically obtaining a reading from a utility meter, the reading being indicative of the usage of the utility, see column 4, lines 6-31;

generating a utility message, the utility message including the reading, see column 4, lines 6-31; and

transmitting the utility message to the processing center, for payment for the usage of the utility, wherein the utility message is transmitted across a transmission medium, see column 2, lines 6-14.

Chasek ('422) does not specifically disclose the processing center being arranged to substantially initiate at least one of a credit transaction and a debit transaction.

Thompson et al (4,948,147) teaches use of Visa or MasterCard, see column 10, lines 8-10 and further equivalency of ACH, credit card or ATM as payment systems, see column 17, lines 54-63 for the benefit of customer convenience.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to utilize as a design choice equivalent any credit card or ACH or ATM system to initiate a credit and debit transaction for the benefit of customer convenience.

As per Claim 11.

Chasek ('422) discloses:

the transmission medium is a network communications line, see column 2, lines 18-31.

As per Claim 12.

Chasek ('422) discloses:

electronically reading the reading from the meter, see column 4, lines 6-31.

As per Claim 27.

Chasek ('422) discloses:

obtaining a utility meter reading, the utility reading being a measure of the usage of the utility, see column 4, lines 6-31;

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generating a utility message the utility message including the reading, column 4, lines 6-31;

transmitting the message to a processing center, see column 2, lines 6-14

a computer readable medium for storing the computer codes, see column 4, lines 6-16;

Chasek ('422) does not specifically disclose the processing center being arranged to effect at least on of a credit transaction and a debit transaction for payment for the utility, wherein the utility message is transmitted across a transmission medium;

Thompson et al (4,948,147) teaches use of Visa or MasterCard, see column 10, lines 8-10 and further equivalency of ACH, credit card or ATM as payment systems, see column 17, lines 54-63 for the benefit of customer convenience.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to utilize as a design choice equivalent any credit card or ACH or ATM system to initiate a credit and debit transaction for the benefit of customer convenience.

6. Claims 13-14, 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chasek (5,894,422).

As per Claim 13, 28.

Chasek ('422) teaches a customer identification code stored in the meter's PROM, passed as part of the meter reading.

Chasek ('422) does not specifically disclose the utility meter, wherein configuring the utility meter includes entering one of a credit account number and a debit account number into the utility meter.

This limitation is seen to be non-functional descriptive material which will not distinguish the invention from the prior art in terms of patentability, see *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 101 (Fed. Cir. 1983).

Therefore it would have been obvious to one of ordinary skill at the time the invention was made to use a credit or debit account number as a customer identifier for the benefit of uniquely identifying the account to be billed.

As per Claim 14.

Chasek ('422) teaches a fourth message in which customer identification code stored in the meter's PROM, is passed as part of the meter reading.

Chasek ('422) does not specifically disclose generating a utility message includes creating a second message field including one of a credit account number and a debit account number.

This limitation is seen to be non-functional descriptive material which will not distinguish the invention from the prior art in terms of patentability, see *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 101 (Fed. Cir. 1983).

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Therefore it would have been obvious to one of ordinary skill at the time the invention was made to use a credit or debit account number as a customer identifier for the benefit of uniquely identifying the account to be billed.

***Prior Art Made of Record***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Frew et al (4,803,632) teaches a metering system with a remote display, inside the home, which accepts a credit card payment.

Loe et al (GB 2 313 462) is the closest foreign art and teaches a system of prepaid utility metering which debits from a card at the meter.

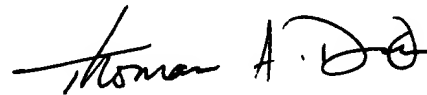
Grzanka "Bringing interactivity to the bill" is the closest non-patent literature teaches utility billing and internet, credit card, debit card and prepay payment of utilities.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (703) 305-4645. The examiner can normally be reached on Monday - Thursday 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

A handwritten signature in black ink, appearing to read "Thomas A. Dixon", with a stylized flourish at the end.

Thomas A. Dixon  
Examiner  
Art Unit 3629

July 29, 2002